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EXAMINER

EDELMAN, BRADLEY E

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

T.R

Office Action Summary	Application No.	Applicant(s)
	09/545,962	MAJOR ET AL.
	Examiner	Art Unit
	Bradley Edelman	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 August 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 23-29 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 23-29 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

This action is in response to Applicant's amendment and request for reconsideration filed on August 24, 2001. Claims 23-29 are presented for further examination. Claims 23-29 are new claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 26 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "substantially" in claim 26 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 23, 24, 27, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz et al. (U.S. Patent No. 5,995,597, hereinafter "Woltz"), in view of Minata (U.S. Patent No. 6,157,318) and Deo et al. (U.S. Patent No. 5,973,612, hereinafter "Deo").

In considering claim 23, Applicant's claims contain three primary features:

- a. Replicating and redirecting data items received at a host system from a plurality of remote systems, via e-mail, to a mobile data communication device.
- b. "Characterizing" the data items at the host system according to data item type and data item priority.
- c. Applying a notification scheme at the mobile communication device, wherein a type of notification alert for receipt of a data item at the mobile device may depend on a person associated with the data item, the data item type, and/or the data item priority.

These features are all well known in the art.

In considering (a), Woltz teaches a host system (host computer 34) that redirects data items received from a plurality of remote systems (i.e. different e-mail addresses), to a mobile data communication device (pagers 28, 30). See col. 3, lines 18-46. The host first stores the messages (col. 3, line 33), and then replicates and redirects the messages via e-mail to the mobile device (col. 4, lines 14-26).

In considering (b), Woltz further teaches characterizing the data items at the host system according to data item type (i.e. received e-mail, Financial News notice, sports scores, schedule reminder message; col. 5, line 58 – col. 6, line 20), and the data item priority (col. 2, lines 34-35; "urgent messages" can be processed at the host). It is well

known that host computers receiving e-mail messages and other data items to forward to a mobile device, can characterize these messages and items according to type and priority (e.g. see Kuki, EP Pat. No. 772,327 A2, col. 5, lines 25-28; col. 7, lines 10-20; see also Eggleston et al. (U.S. Patent No. 6,101,531), col. 8).

In considering (c), Woltz fails to adequately discuss the notification schemes used by the mobile pager device. Nonetheless, the application of separate notification schemes at a mobile communication device, according to information relating to a message being received, is well known, as evidenced by both Minata and Deo.

In a similar art, Minata discloses a paging system, wherein both a priority of messages received at a mobile pager device (col. 2, lines 63-64; col. 3, lines 32-40), and a person associated with the messages received at the device (col. 4, lines 30-38), can determine what type of notification will be used at the device. Additionally, in the same field of art, Deo discloses a paging system, where the data item type of messages (col. 8, lines 1-2) can determine what type of notification will be used at the device. Therefore, given the teaching of Minata and Deo, it is clear that controlling message notification type at a mobile device according to a message data type, a message priority, or a person associated with a message, are all well known. Furthermore, it would have been obvious to a person having ordinary skill in the art to include any or all of these schemes in the pager disclosed by Woltz, so that the user can be notified immediately of whichever specific messages the user believes are the most important (see Deo, col. 2, lines 7-19; see Minata, col. 1, lines 61-63).

In considering claim 24, Deo further discloses the possibility that messages sent from remote systems and routed to the mobile device may have one set of priority characterizations, while the mobile device itself may have a separate set of priority characterizations for the same messages. Deo then describes an elaborate scheme for resolving how to select which priorities take precedence (see col. 10, line 50 – col. 14, line 13). Thus, given the teaching of Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the scheme taught by Deo to resolve any priority disputes between messages received and processed at the host system, and messages received and processed at the Mobile device in the system taught by the Woltz, Minata, and Deo, in order to provide considerable latitude in controlling the notification provided to the user when a page object is received (see Deo, col. 14, lines 6-10). Therefore, it would have been obvious to use the priority resolving method taught by Deo to resolve inconsistent prioritizations between the host and the mobile device in the system taught by Woltz, Minata, and Deo.

In considering claim 27, Woltz further discloses that the data item types include e-mail messages received from the remote systems (col. 3, lines 23-24), and further wherein the e-mail messages are characterized as either inbound e-mail data item types (i.e. archived messages – col. 3, line 33) or outbound e-mail data item types (col. 3, lines 37-40).

In considering claim 28, the combined system taught by Woltz, Minata, and Deo does not disclose the sending of transmission status data items, or characterizing the disclosed e-mail messages as these types. Nonetheless, Woltz discloses that the e-mails can be any type of e-mail (see Abstract), and transmission status e-mails (such as confirmation or receipt) e-mails are well known. Examiner takes official notice that it is further well known for notification of transmission status messages, such as confirmation of delivery and confirmation of receipt messages, to appear as a different icon on standard e-mail programs (such as Microsoft Outlook). Therefore, given the combined teaching of Woltz, Minata, and Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of allowing transmission status messages received at the mobile device to notify the user with a unique notification criteria, so the user can avoid unnecessary fumbling with the device or unnecessary searching through her purse in order to look at the device's visual display. Therefore, it would have been obvious to further characterize messages in the system taught by Woltz, Minata, and Deo as transmission status messages.

3. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz, in view of Minata and Deo, and further in view of Tuoriniemi et al. (U.S. Patent No. 5,978,689, hereinafter "Tuoriniemi").

In considering claim 25, although the system taught by Woltz, Minata, and Deo teaches substantial features of the claimed invention, it fails to disclose providing an earpiece with a speaker, and providing an alert type including a spoken name of a

person associated with the data item. Nonetheless, such an alert scheme is well known, as evidenced by Tuoriniemi. In a similar art, Tuoriniemi discloses a personal portable communication device including a earpiece with a speaker, and which can receive pager messages, telephone calls, and e-mails (Fig. 1; col. 2, lines 35-39), and wherein the user can be notified of incoming messages according to a spoken name of a person sending the message (col. 11, lines 61-67). Therefore, given the teaching of Tuoriniemi, it would have been obvious to a person having ordinary skill in the art to include the spoken name notification alarm disclosed by Tuoriniemi in the pager message forwarding system taught by Woltz, Minata, and Deo, so that the pager user can be immediately aware of who is sending a message (see col. 11, lines 58-60).

4. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woltz, in view of Minata and Deo, and further in view of Croft et al. (U.S. Patent No. 6,078,826, hereinafter "Croft").

In considering claim 26, neither Woltz, Minata, nor Deo discuss power-saving capabilities of the pager system. Nonetheless, allowing pagers or other mobile devices to receive calls while otherwise remaining in a low power state is well known, as evidenced by Croft. In a similar art, Croft discloses a mobile device which remains in a low power state, where the device can receive messages but is otherwise substantially disabled (Abstract). When a call is received, the device will return to a normal power state. Given the teaching of Croft, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using the power saving functions

of the mobile device taught by Croft with the prioritized messaging scheme taught by the combined teaching of Woltz, Minata, and Deo, in order to save battery power in the pager device at all times except true, urgent emergencies (see Woltz, col. 2, lines 34-35). Therefore, it would have been obvious to include the power saving functions of the system taught by Croft in the combined pager messages receiving system taught by Woltz, Minata, and Deo.

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman (U.S. Patent No. 6,034,621), in view of Deo.

In considering claim 29, Kaufman discloses a method of redirecting e-mail messages and meeting notices from a host system to a mobile data communication device via a wireless network, comprising the steps of:

receiving e-mail messages and meeting notices from a plurality of remote systems at the host system (col. 1, lines 48-62; col. 3, lines 1-5; wherein such messages are inherently sent from a plurality of remote systems, and both e-mails and meeting notices can be sent via Microsoft's Schedule+ or Outlook program); and generating a plurality of electronic envelopes at the host system, wherein the electronic envelopes include the received e-mail messages or meeting notices, redirecting the envelopes from the host system to the mobile device via a wireless network, and receiving the envelopes at the mobile device (envelopes are inherent in the forwarding of messages from the host to the mobile device – see col. 3, lines 1-5; col. 4, lines 30-44).

Furthermore, Outlook, which is included in the system taught by Kaufman, inherently includes a priority field and message type field for its messages.

However, Kaufman does not explicitly disclose the claimed characterization steps, wherein the envelopes containing the messages are characterized at the host system according to the data type or priority, the data type or priority is extracted at the mobile device in order to effect the alert type according to a specific notification scheme, and the data type or priority can be user-defined. Nonetheless, such a characterization system is well known, as evidenced by Deo. In a similar art, Deo discloses a system that also utilizes Microsoft's Schedule+ and Outlook programs, for forwarding messages from a host to a mobile device, wherein different messages can be characterized according to a user preference, and wherein those characterizations will effect the alarm type at the mobile device according to a specific notification scheme (col. 7, lines 19-21, 55-58; col. 8, lines 1-2, 16-26). Given the teaching of Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of using different notification schemes for the different types or priorities of messages taught by Kaufman, so that a user who has lost his reading glasses would not have to strain his eyes to look at the small screen of the mobile device. Therefore, it would have been obvious to include different notification schemes, as taught by Deo, for the messaging system taught by Kaufman.

Response to Arguments

Applicant's arguments with respect to claims 23-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-

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3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.

BE
November 13, 2001



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
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